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09/442,727	11/18/1999	SADAHARU SATO	450100-02171	6321
20999	7590	07/23/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			VAUGHAN, MICHAEL R	
			ART UNIT	PAPER NUMBER
			2131	19

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/442,727

Applicant(s)

SATO, SADA HARU

Examiner

Michael R Vaughan

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Detailed Office Action**

Claims 1-8 have been fully reconsidered and are pending.

***Response to Arguments***

Applicant's arguments filed 6-17-04 have been fully considered but they are not persuasive with respect to the allegation that neither Szczutkowski nor Cookson teach or suggest "a transmission circuit for adding enciphering information representative of the cipher mode to the data enciphered in the cipher processing circuit. Cookson teaches this feature explicitly in Figure 1. Examiner has already provided the motivation to combine Szczutkowski and Cookson as cited in the previous office action and repeated below in the rejection of claim 1. The copy states of Cookson are equivalent to the claimed enciphering information representative of the cipher mode to the data enciphered.

Additional arguments are moot in view of a new ground of rejection.

***Claim Rejections - 35 USC § 103***

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szczutkowski et al. (USP 4,817,146) in view of Cookson et al (USP 5,896,454) in view of Dent (USP 6,690,798).

As per claim 1, Szczutkowski et al. teach:

A cipher processing circuit for enciphering data (column 4, lines 42-66);

A transmission circuit for adding the enciphering information representative of the cipher mode to the data enciphered to the data enciphered in the cipher processing circuit (see FIG. 1);

Transmitting the result to the serial interface bus (column 8, lines 60-63);

Confirming the continuity of the cipher mode (column 7, lines 5-40 and column 8, lines 20-40);

Transmitting in a different cipher mode when a discontinuity is confirmed (column 20, lines 16-36).

Szczutkowski et al do not teach that one of the cipher modes is a copy once prohibition mode wherein the data cannot be reproduced more than once. Cookson et al teach a copy once prohibition mode wherein the data cannot be reproduced more than once (Fig 2 and column 4, lines 26-32). It is advantageous to provide an additional mode of copying to allow one to make a backup of an original storage of data. This allows a legitimate owner of a piece of data to make a backup copy. In addition it is desirable to prevent a malicious user from making multiples copies from a copy.

In view of this it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the teachings of Cookson et al within the system of Szczutkowski et al because it would allow the system to authorize a one time copy so

that a backup can be made of the original piece of data, while preventing illegal subsequent copies from being made from the copy.

Szczutkowski et al teach when the data enciphered by a different cipher mode to the serial interface bus and a discontinuity is confirmed, to use a different mode of decryption (column 20, lines 16-36). Szczutkowski et al do not explicitly teach transmitting the data enciphered by a different cipher mode when the cipher mode and the enciphering information are determined not to correspond. Examiner notes the broadness of the previous limitation. It is not clear by the language of the claim if the cipher mode and the enciphering information correspond to one another or collectively correspond to another entity. The nature of the limitation is open to several different interpretations. Dent teaches a cipher mode indication causes a change in the way data is enciphered when any number of situations occurs (column 16, lines 26-45). Examiner has interpreted this as being the same as an establishment, positive or negative, to a correspondence with some variable. Therefore the sender changes the ciphering mode with a cipher mode indication when a certain condition is met. One condition as taught by Dent, is when the previous cipher mode indication and current cipher mode indication value are different (column 15, lines 47-55). In view of this it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the teachings of Dent within the system of Szczutkowski because it would ensure the receiver can correctly decrypt various modes of ciphering and help to efficiently remain synchronized.

As per claim 2, Szczutkowski et al. teach setting the enciphering information in a predetermined region of a header of the packet (column 17, lines 10-12 and column 19, lines 34-51).

As per claim 3, Szczutkowski et al. teach:

A holding means in which information of at least one cipher mode is set (FIG. 1);

A control means for specifying a mode to encipher (FIG. 1);

A cipher processing circuit including a cipher mode selection circuit and a cipher engine circuit for enciphering data and outputting data (FIG. 1 and column 7, lines 5-45);

A transmission circuit for adding the enciphering information to the enciphered data (FIG. 1);

Transmitting the result to the serial interface bus (column 8, lines 60-63);

Confirming the continuity of the cipher mode (column 7, lines 5-40 and column 8, lines 20-40);

Transmitting in a different cipher mode when a discontinuity is confirmed (column 20, lines 16-36).

Szczutkowski et al do not teach that one of the cipher modes is a copy once prohibition mode wherein the data cannot be reproduced more than once. Cookson et al teach a copy once prohibition mode wherein the data cannot be reproduced more than once (Fig 2 and column 4, lines 26-32). It is advantageous to provide an additional

mode of copying to allow one to make a backup of an original storage of data. This allows a legitimate owner of a piece of data to make a backup copy. In addition it is desirable to prevent a malicious user from making multiples copies from a copy.

In view of this it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the teachings of Cookson et al within the system of Szczutkowski et al because it would allow the system to authorize a one time copy so that a backup can be made of the original piece of data, while preventing illegal subsequent copies from being made from the copy.

The examiner supplies the same rationale for the motivation as recited in the rejection of claim 1 to incorporate the teachings of Dent within the system of Szczutkowski.

As per claim 4, Szczutkowski et al. teach setting the enciphering information in a predetermined region of a header of the packet (column 17, lines 10-12 and column 19, lines 34-51).

As per claim 5, Szczutkowski et al. teach:

A storing means (FIG. 1);

A holding means in which information of at least one cipher mode is set (FIG. 1);

A control means for specifying a mode to encipher (FIG. 1);

A cipher processing circuit including a cipher mode selection circuit for selecting cipher mode information specified by the control means from the holding means and a

cipher engine (DES) circuit for enciphering the data to be transmitted in the cipher mode selected and outputting the enciphered data (FIG. 1 and column 7, lines 5-45);

A first transmission circuit for generating time information (column 17, lines 3-47) to output received data on a receiving side to an application side (column 11, lines 43-48);

A second transmission circuit for reading enciphered data (FIG. 1), generating packet data (FIG. 1), setting enciphering information in a packet header (column 17, lines 10-12 and column 19, lines 34-51) and transmitting the result to a serial interface bus (column 8, lines 60-63), confirming the continuity of the cipher mode (column 7, lines 5-40 and column 8, lines 20-40), and transmitting in a different cipher mode when a discontinuity is confirmed (column 20, lines 16-36).

Szczutkowski et al do not teach that one of the cipher modes is a copy once prohibition mode wherein the data cannot be reproduced more than once. Cookson et al teach a copy once prohibition mode wherein the data cannot be reproduced more than once (Fig 2 and column 4, lines 26-32). It is advantageous to provide an additional mode of copying to allow one to make a backup of an original storage of data. This allows a legitimate owner of a piece of data to make a backup copy. In addition it is desirable to prevent a malicious user from making multiples copies from a copy.

In view of this it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the teachings of Cookson et al within the system of Szczutkowski et al because it would allow the system to authorize a one time copy so



that a backup can be made of the original piece of data, while preventing illegal subsequent copies from being made from the copy.

The examiner supplies the same rationale for the motivation as recited in the rejection of claim 1 to incorporate the teachings of Dent within the system of Szczutkowski.

As per claim 6, Szczutkowski et al. teach:

A cipher processing circuit for enciphering data to be transmitted by a predetermined cipher mode (column 7, lines 5-45) at the time of transmission and deciphering the received enciphered data based on the enciphering information included in the received packet data (column 19, line 34 – column 20, line 36);

A transmission circuit for adding enciphering information to the enciphered data (column 19, lines 34-51 and column 17, lines 10-12), transmitting result to a serial interface bus (column 8, lines 60-63), confirming the continuity of the cipher mode (column 7, lines 5-40 and column 8, lines 20-40), and transmitting in a different cipher mode when a discontinuity is confirmed (column 20, lines 16-36).

Szczutkowski et al do not teach that one of the cipher modes is a copy once prohibition mode wherein the data cannot be reproduced more than once. Cookson et al teach a copy once prohibition mode wherein the data cannot be reproduced more than once (Fig 2 and column 4, lines 26-32). It is advantageous to provide an additional mode of copying to allow one to make a backup of an original storage of data. This

allows a legitimate owner of a piece of data to make a backup copy. In addition it is desirable to prevent a malicious user from making multiples copies from a copy.

In view of this it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the teachings of Cookson et al within the system of Szczutkowski et al because it would allow the system to authorize a one time copy so that a backup can be made of the original piece of data, while preventing illegal subsequent copies from being made from the copy.

The examiner supplies the same rationale for the motivation as recited in the rejection of claim 1 to incorporate the teachings of Dent within the system of Szczutkowski.

As per claim 7, Szczutkowski et al. teach setting the enciphering information in a predetermined region of a header of the packet (column 17, lines 10-12 and column 19, lines 34-51).

As per claim 8, Szczutkowski et al. teach:

A first storing means (FIG. 6);

A second storing means (FIG. 6);

A holding means in which information of at least one cipher mode is set (FIG. 1);

A control means for specifying a mode to encipher (FIG. 1);

A first reception circuit for storing time information, enciphered data, and the enciphering information from received packets (FIG. 1, 2, 6, and column 20, lines 36-40);

A second reception circuit for outputting enciphering information and enciphered data to an application based on time information (FIG. 1, 2, 6, and column 21, lines 58-63 and column 17, lines 5-48);

A cipher processing circuit including a cipher mode detection circuit (column 20, lines 16-36);

A cipher mode selection circuit (column 7, lines 31-45);

A cipher engine for enciphering and deciphering (FIG. 1);

A first transmission circuit for generating time information (column 17, lines 3-47) to output received data on a receiving side to an application side (column 11, lines 43-48);

A second transmission circuit for reading enciphered data (FIG. 1), generating packet data (FIG. 1), setting enciphering information in a packet header (column 17, lines 10-12 and column 19, lines 34-51) and transmitting the result to a serial interface bus (column 8, lines 60-63), confirming the continuity of the cipher mode (column 7, lines 5-40 and column 8, lines 20-40), and transmitting in a different cipher mode when a discontinuity is confirmed (column 20, lines 16-36).

Szczutkowski et al do not teach that one of the cipher modes is a copy once prohibition mode wherein the data cannot be reproduced more than once. Cookson et al teach a copy once prohibition mode wherein the data cannot be reproduced more

than once (Fig 2 and column 4, lines 26-32). It is advantageous to provide an additional mode of copying to allow one to make a backup of an original storage of data. This allows a legitimate owner of a piece of data to make a backup copy. In addition it is desirable to prevent a malicious user from making multiples copies from a copy.

In view of this it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the teachings of Cookson et al within the system of Szczutkowski et al because it would allow the system to authorize a one time copy so that a backup can be made of the original piece of data, while preventing illegal subsequent copies from being made from the copy.

The examiner supplies the same rationale for the motivation as recited in the rejection of claim 1 to incorporate the teachings of Dent within the system of Szczutkowski.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R Vaughan whose telephone number is 703-305-0354. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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